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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,705	09/26/2003	Robert R. Gallucci	136138-1	1122

7590

04/06/2005

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EXAMINER

HAMPTON HIGHTOWER, PATRICIA

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,705

Applicant(s)

GALLUCCI ET AL.

Examiner

Patricia Hightower

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 13-65 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/05/05: 3/14/05</u> | 6) <input type="checkbox"/> Other: _____ |

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Information Disclosure Statement

The information disclosure statements filed January 05, 2005 and March 14, 2005 have been considered and have been made of record.

Response to Amendment

In view of applicants' response filed January 05, 2005 the rejection of the claims under 35 USC 103(a) as being obvious over Peters (USP 4,965,337) has been withdrawn because the reference does not suggest or teach as claimed analyzing the reaction product for residual amine or anhydride end groups or the addition of additional monomer to keep the total amine and anhydride end groups concentration below 20 meq.kg of resin.

However, the claims 1-12 are subject to a new ground of rejection under 35 USC 102(b) as anticipated by Dellacoletta (USP 4,910,288 newly cited).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 are newly rejected under 35 U.S.C. 102(b) as being anticipated by Dellacoletta (USP 4,910,288) newly cited.

Dellacoletta (USP 4,910,288 newly cited) discloses a polyetherimide and a process for preparing wherein an improved solution polymerization process for the preparation of polyetherimides comprises pre-reacting an aromatic bis(ether anhydride)

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with an aromatic diamine followed by the addition of phthalic anhydride end capping agent and further reaction to form an endcapped prepolymer, the prepolymer is converted into the polyetherimide. See abstract; cols. 1-10; the examples and the claims.

Although the reference is silent as to the glass transition temperature and a residual volatile species concentration of less than 500 ppm, a total reactive end group concentration of less than about 120 milliequivalents/kilogram resin, the weight average molecular weight of the resulting polyetherimide. Given that Dellacoletta discloses a polyetherimide as instantly claimed prepared from reactants inclusive of those claimed; the position is taken that the polyetherimide of Dellacoletta would inherently possess said properties or characteristics since both are of the same structural identity.

Applicant's arguments with respect to claims 1-65 have been considered but are moot in view of the new ground(s) of rejection.

Claims 13-65 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia Hightower whose telephone number is (571) 272-1073. The examiner can normally be reached on M-F from 9:30 A.M. - 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


P. Hampton Hightower
Primary Examiner
Art Unit 1711

P. Hightower:ph
April 02, 2005